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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/930,235 02/23/98 EITRICH

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EXAMINER

LOVERING, R

ART UNIT

PAPER NUMBER

1721

12

DATE MAILED: 11/05/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/930,235

Applicant(s)

EITRICH ET AL.

Examiner

LOVERING

Group Art Unit

1721

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on AUG. 20 & OCT. 12, 1999.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-3 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-3 is/are rejected.
- ☒ Claim(s) 2 AND 3 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 11
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Schambil et al. DE 4,010,393, esp. Beispiele; Table 1; and abstract. As to the expression "≥11.85% by weight of" an oil phase in claims 1 and 3, it is well-settled that limitations which are new matter cannot be considered in passing on claims. See In re Mims, 56 USPQ 536: 553 O.G. 6.

3. Claims 1-3 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Allard et al. 5,616,331 of record. The instantly - claimed transparent or Translucent micromulsions and process for preparing them are anticipated by Allard et al. (esp. Ex. 1; paragraph bridging col's . 2 and 3; col. 5, lines 47-65; and col. 6, lines 39-47), or are at least clearly within the purview of Allard et al., and thus would have been obvious therefore to one having ordinary skill in the art at the time applicants' invention was made. As stated in the preceding paragraph, as to the expression " ≤11.85% by weight of" an oil phase in claims 1 and 3, it is well - settled that limitations which are new matter cannot be considered in passing on claims. See the Mims decision cited above. Even if the quoted expression were considered, it is evident from Allard et al. (col. 5, lines 28-43, esp. lines 34-36) that patentees contemplate the use of as little as 5% oily phase, and it would have been obvious to one skilled in the art to use such a low oily phase concentration in the microemulsions of Allard et al. to render them less expensive by reducing the amount of the oily phase relative to the aqueous phase.

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4. Claims 2 and 3 are objected to for using passive instead of active forms verbs.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1 and 3 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The expression " $\leq 11.85\%$  by weight" of an oil phase lacks antecedent basis and support in the disclosure, and is considered new matter. The oil phase ingredients in Ex. 4 do not add up to 11.85%.

7. Applicant's arguments filed August 29, 1999 have been fully considered but they are not persuasive. Schambil et al. (page 3, line 57) indicate that their microemulsions are transparent. The issue concerning the oil phase concentration has been dealt with above-herein.

8. The disclosure is objected to because of the following informalities: The specification lacks: -- BRIEF DESCRIPTION OF DRAWINGS --.

Appropriate correction is required.

9. The remaining references listed on applicant's PTO1449 filed October 12, 1999 have been considered and made of record.

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication should be directed to Examiner Lovering at telephone number (703) 308-0443.

Examiner Lovering/om  
November 4, 1999

RICHARD D. LOVERING  
PRIMARY EXAMINER  
GROUP 1200 1700